

REMARKS

Claims 1-3, 5-7, 14-21, and 34-36 are pending in the application. Claim 1 is currently amended.

Claim 1 has been broadened to delete the list of conditions, since the Examiner affords this passage no patentable weight, asserting that no structural difference flows from the functional distinction formerly claimed. However, the specification supports a premise that the functionality that was formerly claimed is an inherent property of the composition.

The office action rejects claims 1-3, 5-7, and 14 over EP 506,207 in view of The Merck Index. EP '207 is applied as showing a list of equivalent antimycotics that may be applied in combination with zinc chloride to achieve an antimycotic effect. Although the list of antimycotics includes halogenated and sulfated forms of 8-hydroxyquinoline, 8-hydroxyquinoline is not expressly disclosed. Merck is used to show that 8-hydroxyquinoline may have an antimycotic effect. The examiner reasons that this makes obvious what is claimed because 8-hydroxyquinoline could have been included as an equivalent antimycotic, since EP '207 teaches the use of zinc chloride to enhance the intended effect of any pharmacologically active agent.

The rationale for rejection is unsound because it fails to accommodate an observed difference in kind. This is compounded by a failure to consider the functional differences that were formerly claimed. Although the examiner correctly observes that functional language does not always provide a structural distinction, that is not the end of the story. It is impossible to separate a pharmacological composition from its functional [properties, and it is absolutely necessary to consider this when assessing the patentability of what

Returning now to the decision of the board in this case, we think that it rests on one fundamental error of law, namely, the failure to take into consideration the biological or pharmaceutical property of the compounds as anti-inflammatory agents on the ground that to chemists the structure of the compounds would be so obvious as to be beyond doubt, and that a showing of such properties is to be used only to resolve doubt.

From the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing. The graphic formulae, and the chemical nomenclature, the systems of classification and study such as the concepts of homology, isomerism, etc., are mere symbols by which compounds can be identified, classified, and compared. But a formula is not a compound and while it may serve in a claim to identify what is being patented, as the metes and bounds of a deed identify a plot of land, the thing that is patented is not the formula but the compound identified by it. And the patentability of the thing does not depend on the similarity of its formula to that of another compound but of the similarity of the former compound to the latter. There is no basis in law for ignoring any property in making such a comparison. An assumed similarity based on a comparison of formulae must give way to evidence that the assumption is erroneous.

In re Papesch, 50 C.C.P.A. 1084, 1097 (C.C.P.A. 1963).

Thus, in context of the present claims, the presumed commonality of antimycotic functionality is merely one thing to consider. The allegation of obviousness is completely rebutted by a showing that the functionality differs in kind. The claimed composition is extremely potent against cancer. Now consider the comparison as shown by declaration. Select 8-hydroxyquinoline sulfate as an antimycotic from the list in EP '207. Apply this to a cancer or precancer lesion in combination with zinc chloride to assess efficacy against the lesion. The candidate fails. Repeat the experiment for 8-hydroxyquinoline in non-sulfated form. The lesion is destroyed. It is destroyed selectively without material damage to the surrounding tissue. This is what the Declarations of record show in this case, confirming the patentability of what is claimed by a showing that the functionality differs in kind from the expected antimycotic functionality. Moreover, since the prior art failed to appreciate that difference in what it expressly taught, what is claimed is patentable even without the weight of this additional evidentiary showing since 8-hydroxyquinoline is clearly a less preferred antimycotic because it is not included in the EP '207 list, but excels in the composition as claimed.

The claims are patentable for the above reasons. This response is being filed with required fees for a 3 month Extension of Time. Applicant believes that no additional fees are due at this time. However, if any additional fees are due, the Commissioner is authorized to charge them to deposit account No. 12-0600.

Respectfully submitted,

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